The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SHUANG LIU, JOHN A. BARRETT, and ALAN P. CARPENTER

Appeal 2007-3262
Application 09/899,629
Technology Center 1600

Decided: August 14, 2007

Before DONALD E. ADAMS, DEMETRA J. MILLS, and LORA M. GREEN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

On consideration of the record, we find this case is not in condition for a decision on appeal. For the reasons that follow, we remand the application to the Examiner to consider the following issues and to take appropriate action.

DISCUSSION

This is the second time this application has come before this Merits Panel. A decision was entered into the record on the first appeal (Appeal No. 2005-2132) on August 30, 2005 vacating all pending rejections and remanding the application to the Examiner for further consideration.

Upon receipt of the decision in Appeal No. 2005-2132, the Examiner entered an Office Action into the record on January 18, 2006 finally rejecting claims 19-22, 20-33, and 35-59 (Final Rejection, dated January 18, 2006). In response, Appellant filed a Notice of Appeal on May 18, 2006. An "Electronic Acknowledgement Receipt" (Receipt) was entered into the record on May 18, 2006 acknowledging the receipt of Appellants' Notice of Appeal (Receipt, dated May 18, 2006 2[1]).

A second Receipt was entered into the record on October 17, 2006 acknowledging the receipt of Appellants' Brief having the file name "BMS2027Brief.pdf" (Receipt, dated October 17, 2006 2[2]). The Examiner then entered an Answer into the record on February 8, 2007. The Answer states that it "is in response to the appeal brief filed October 17 appealing from the Office action mailed January 18, 2006" (Answer 1).

The problem, however, is that Appellants' October 17, 2006 Brief is not part of this application's electronic file. Therefore, the administrative file is incomplete. As a result, we are unable to proceed with a review of the merits of this appeal.

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[1] This document is not paginated. Therefore, we refer to page numbers as if the document was numbered consecutively starting with the first page.
[2] This document is not paginated. Therefore, we refer to page numbers as if the document was numbered consecutively starting with the first page.

Accordingly, we remand the application to the Examiner to locate Appellants' Brief and enter the Brief into the administrative record (e.g., the electronic file wrapper).

OTHER ISSUE

In our previous decision in Appeal No. 2005-2132, we vacated both (1) obviousness-type double patenting rejection and (2) the rejection under 35 U.S.C. § 103; and "remand[ed] the application to the [E]xaminer to clarify how each element of [A]ppellants' claimed invention relates to the combination" of prior art relied upon in each rejection (VACATUR and REMAND 6-7). A review of the Answer (mailed February 8, 2007) reveals that the Examiner did not provide an explanation of how each limitation in each of Appellants' appealed claims is taught by the combination of prior art relied upon. Accordingly, in the event that Appellants' Brief separately groups and argues the claims, the Examiner should take this opportunity to clearly explain how the combination of prior art reaches the subject matter of each claim (or grouping of claims) separately argued in Appellants' Brief.

CONCLUSION

In summary, we remand the application to the Examiner.

REMANDED

BRISTOL - MYERS SQUIBB COMPANY
PATENT DEPARTMENT
PO BOX 4000
PRINCETON NJ 08543-4000